

REMARKS

This Amendment is submitted simultaneously with filing of the above identified application.

In the present Amendment applicant has amended claims 1 and 13, the broadest apparatus and method claims.

It is respectfully submitted that in the independent claims it is now defined that the supplementary motor is a starter generator/motor of the internal combustion engine and the auxiliary system is a climate control compressor.

The new features of the present invention are not disclosed in the prior art. The inventive structure and step in the present invention as defined now in amended claims 1 and 13 is that the invention uses an existing part of a motor vehicle, namely the starter generator/motor to provide the functionality of the supplementary motor. These features provide for the highly advantageous results, and the benefits of these features include the reductions of manufacturing costs and room savings. Also, the

potential defect sources of an extra supplementary motor are eliminated. The auxiliary system formed as the climate control compressor also is not known.

The above mentioned new features of the present invention are not disclosed in the prior art applied by the Examiner against the original claims. The prior art does not teach these features and there are not hint or suggestion in the references that such features can be provided in the construction disclosed in the references. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified by including into them the above mentioned new features of the present invention which are defined now in amended claims 1 and 13. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference

to modify its structure to one which prior art references do not suggest.

Definitely, the prior art does not provide any hint or suggestion for such modifications.

As explained herein above, the present invention provides for the highly advantageous results which are not accomplished by the construction disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.


In view of the above presented remarks and amendments, it is believed that claims 1 and 13 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share their presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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